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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,803	11/16/2003	Robert G. Colantuono	750.1168CIP	2957

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EXAMINER

CHUNG TRANS, XUONG MY

ART UNIT PAPER NUMBER

2833

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,803

Applicant(s)

COLANTUONO ET AL.

Examiner

Xuong M. Chung-Trans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/6/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. This application has been examined. Claims 1-12 are pending in this application.

### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 12 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 48 of copending Application No. 10/292,803. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. In reference to independent claims, the limitation of convergent is not shown in the drawings. Page 37 of the specification discloses that 108 and 109 converge, but figures 31-34 are distorted photocopies that do not clearly show so that one skilled in the art knows the meets and bounds of what applicant is claiming. Therefore, the convergent limitation must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

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Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinney et al. (USPN 5,547,405).

Pinney discloses in figs. 1-10 an electric connector for data transfer applications, comprises at least eight sequentially positioned elongate contact members connected in a series of signal pairs; a first signal pair and a second signal pair. One contact of each pair is configured differently from the other member of the pair, the respective contact members being oriented relative to one another such that they substantially remain in generally parallel planes, but define non-parallel paths. Each of the selected contact

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members (A,C,B,D) mounts a plate-like extension (110, 122) oriented in a first direction and in respective planes generally parallel to one another. Each pair of extensions is separated by a first dielectric (112) such that a first capacitor is formed. Furthermore, each of the selected contact members (A,C,B,D) mounts a plate-like extension (110,122) oriented in a second direction and also in respective planes generally parallel to one another, and each pair of extensions is likewise separated by a second dielectric (112) such that a second capacitor is formed. Each contact of each contact member pair has a plug engaging portion and a board engaging portion, the plurality of contact members having a selected shape, being arranged relative to one another, and being housed collectively by a dielectric casing (24) so as to minimize cross-talk during data transfer. Pinney does not explicitly disclose the pair numbering as claimed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any numbering scheme or pair assignment can be made in order to easily identify the pair as needed. Pinney does not explicitly disclose that the orientation of the plate-like extensions in the first direction is generally convergent with the second direction. However, it would have been obvious to one skilled artisan the art at the time the invention was made that the orientation of the plate-like extensions in the first direction is generally convergent with the second direction because the extension can be bent in any other direction and thereby the compensation structure (i.e. the capacitance level) can be vary by adjusting the size and spacing of the plate;

As per claims 2-3, Pinney teaches that at least one of the dielectrics comprises a polymeric material (col. 4, lines 36-37).

As per claim 4, it is obvious that the conductor can be pure copper to obtain high conductivity.

As per claim 5, Pinney teaches that the capacitor is a flat plate capacitor.

As per claim 6, Pinney teaches that each conductive member having a plate-like extension is formed with the extension as one-piece unit.

As per claim 7, Pinney teaches the total surface area of the extension of the first capacitor is equivalent to that of the second capacitor extension.

As per claim 8, it is obvious that the total surface area of the extension of the first capacitor is unequal to that of the second capacitor extension because the capacitance level can be adjusted by adjusting the size and spacing of the plate.

Claim 10 recites a method substantially similar to the connector claim 1; therefore, it is rejected under the similar rationale. Further, it is noted that claim 10 differs from claim 1 in that it recites a first electric device is joined to a jack connector and a second device is joined to a plug connector and inserting the plug connector into the jack connector to establish between the first and second electric devices. However, such limitation is inherent in the plug and jack connector.

9. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmel (USPN 6,290,524).

Simmel discloses in figs. 1-5 an electric connector for data transfer applications, comprises at least eight sequentially positioned elongate contact members are connected in a series of signal pairs; a first signal pair; a second signal pair a third

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signal pair; and a fourth signal pair. One member of each contact member pair is configured differently from the other member of the pair, the respective contact members being oriented relative to one another such that they substantially remain in generally parallel planes, but define non-parallel paths. Each of the selected contact members (16) mounts a plate-like extension (24,26) oriented in a first direction and in respective planes generally parallel to one another. Each pair of extensions is separated by a first dielectric (the wall between the passage 14) such that a first capacitor is formed. Furthermore, each of the selected contact members (16) mounts a plate-like extension (24,26) oriented in a second direction and also in respective planes generally parallel to one another, the first direction being generally convergent with the second direction and each pair of extensions is likewise separated by a second dielectric (the wall between the passage 14) such that a second capacitor is formed. Each contact of each contact member pair has a plug engaging portion (20) and a board engaging portion (18), the plurality of contact members having a selected shape, being arranged relative to one another, and being housed collectively by a dielectric casing (12) so as to minimize cross-talk during data transfer. Simmel does not explicitly disclose the pair numbering as claimed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any numbering scheme or pair assignment can be made in order to easily identify the pair as needed. Simmel does not explicitly disclose that the orientation of the plate-like extensions in the first direction is generally convergent with the second direction. However, it would have been obvious to one skilled artisan the art at the time the invention was made that the



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orientation of the plate-like extensions in the first direction is generally convergent with the second direction because the extension can be bent in any other direction as needed and thereby the compensation structure (i.e. the capacitance level) can be vary by adjusting the size and spacing of the plate.

Claim 10 recites a method substantially similar to the connector claim 1 therefore, it is rejected under the similar rationale. Further, it is notes that claim 10 differs from claim 1 in that it recites a first electric device is joined to a jack connector and a second device is joined to a plug connector and inserting the plug connector into the jack connector to established between the first and second electric devices. However, such limitation is inherent in the plug and jack connector.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinney et al. (USPN 6,290,524) in view of Foster, Jr., deceases et al. (5,586,914).

Claim 9 differs from claim 1 in that it recites that one contact of each of the first, third and fourth signal pairs crossing over the other contact of the pair so as to reverse the positions occupied by the respective contacts along their non-parallel paths. Pinney discloses the invention substantially as claimed except for one contact of each of the first, third and fourth signal pairs crossing over the other contact of the pair so as to reverse the positions occupied by the respective contacts along their non-parallel paths. Foster discloses such one contact of each signal pairs crossing over the other contact of the pair (fig. 5 and col. 10, lines 8-57). Therefore, it would have been obvious to one

skilled in the art at the time the invention was made to include the teaching of Foster to provide addition compensation for crosstalk between the contacts.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simmel (USPN 6,290,524) in view of Foster, Jr., deceases et al. (5,586,914).

Claim 9 differs from claim 1 in that it recites that one contact of each of the first, third and fourth signal pairs crossing over the other contact of the pair so as to reverse the positions occupied by the respective contacts along their non-parallel paths. Pinney discloses the invention substantially as claimed except for one contact of each of the first, third and fourth signal pairs crossing over the other contact of the pair so as to reverse the positions occupied by the respective contacts along their non-parallel paths. Foster discloses such one contact of each signal pairs crossing over the other contact of the pair (fig. 5 and col. 10, lines 8-57). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to include the teaching of Foster to provide addition compensation for crosstalk between the contacts.

12. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Adriaenssens et al. (USPN 6042427).

As per claim 12, Adriaenssens et al. discloses in figs. 1-3 an electric connector for high performance data transfer which comprises a plurality of elongate contact member pairs, generally flat plate capacitors (60a,60b) being positioned within

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alternating members of at least two of the contact member pairs so as to enhance cross-talk reduction during data transfer.

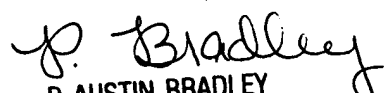
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xuong M. Chung-Trans whose telephone number is (571) 272-2002. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 extension 33.. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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